



Docket No.: 2292-0038-0 PCT



ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

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RE: Application Serial No.: 08/722,144  
Applicants: Masaji ISHIGURO, et al.  
Filing Date: December 12, 1996  
CPA Filed: July 9, 1999  
For: PENEM DERIVATIVES AND ANTIMICROBIAL AGENT  
CONTAINING THE SAME  
Group Art Unit: 1624  
Examiner: Berch, M.

SIR:

Attached hereto for filing are the following papers:

**Petition Under 37 CFR §1.181 to Vacate Notice of Improper CPA Filing Under 37 C.F.R. 1.53(d)  
Notice of Improper CPA Filing Under 37 CFR 1.53(d) (copy)**

Our check in the amount of **\$130.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Norman F. Oblon  
Attorney of Record  
Registration No. 24,618

Harris A. Pitlick  
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**22850**

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2292-0038-0 PCT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :  
MASAJI ISHIGURO ET AL : EXAMINER: BERCH, M  
SERIAL NO. : 08/722,144 :  
FILED: DECEMBER 12, 1996 : GROUP ART UNIT: 1624  
CPA FILED: JULY 9, 1999  
FOR: PENEM DERIVATIVES AND :  
ANTIMICROBIAL AGENT  
CONTAINING THE SAME

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PETITION UNDER 37 CFR §1.181 TO VACATE NOTICE OF IMPROPER CPA FILING  
UNDER 37 C.F.R. §1.53(d)

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

Applicants respectfully request that a Notice of Improper CPA Filing under 37 C.F.R. §1.53(d), mailed July 26, 2001 ("Notice"), be vacated, and that a CPA filing date of June 27, 2001 be granted.

A request for a CPA was filed on June 27, 2001 (most-recently filed CPA). A previous CPA was filed July 9, 1999 (prior-filed CPA), but without the filing fee. In response to a Notice to File Missing Parts, Applicants paid the filing fee, and other fees due, on September 11, 2000.

The Notice asserts that the most-recently filed CPA is improper, because the prior-filed CPA was filed after May 29, 2000.

09/27/2001 CNGUYEN 00000135 08722144

01 FC:122

130.00 OP

08/27/2001 08:50:35 10722144  
130.00 OP

09/27/2001 AWELTY 00349000  
08/27/2001 08:50:35 10722144  
130.00 OP

While, as discussed above, the filing fee for the prior-filed CPA was filed after May 29, 2000, the PTO, in granting the July 9, 1999, filing date, in effect held that this CPA was filed on that date, and not on the subsequent date on which the filing fee was actually paid.

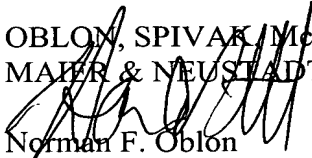
Applicants recognize the 37 C.F.R. §1.53(d)(i)(A) provides that a CPA may be filed provided the prior nonprovisional application is filed under 35 U.S.C. §111(a) before May 29, 2000, and is complete as defined by §1.51(b). Nevertheless, based on telephone conversations with professionals in the Office of Patent Legal Administration, and particularly with Legal Advisors Robert Clarke and Mark Polutta, undersigned counsel was orally briefed by Mr. Polutta that granting of the presently-requested CPA filing date of June 27, 2001 is consistent with the interpretation of the Office of the above-discussed 37 C.F.R. §1.53(d)(i)(A).

This petition is filed because nothing has yet been received in writing, and the 2-month deadline provided by 37 C.F.R. §1.181(f) will soon expire.

For all of the above reasons, it is respectfully requested that the Notice be vacated,  
and that a CPA filing date of June 27, 2001, be granted.

Respectfully submitted,

OBLON, SPIVAK, MCCLELLAND,  
MAIER & NEUSTADT, P.C.

  
Norman F. Oblon  
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Registration No. 24,618

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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
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Washington, D.C. 20231

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
08/722,144	12/12/96	ISHIGURO	M 2292-038-0 <i>PGT</i>

022850  
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DATE MAILED: 1/24

07/26/01

OBLON, SPIVAK, McCLELLAND  
MAIER & NEUSTADT, P.C.

Ref. Re: *Proper* PAGE  
9-26-01 (NM-6a)

**NOTICE OF IMPROPER CPA FILING UNDER 37 CFR 1.53(d)**  
**No Filing Date Granted**

The Continued Prosecution Application (CPA) request deposited on 6/27/01 is improper under 37 CFR 1.53(d) and has not been granted a filing date for reason(s) indicated below.

Any assertions that the above-mentioned CPA request is proper under 37 CFR 1.53(d) must be by way of petition directed to the attention of the Office of Petitions. Any such petition must be accompanied by the \$130.00 petition fee (37 CFR 1.17(n)). If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

A petition under 37 CFR 1.53(e) as discussed above must be submitted within TWO MONTHS of the date of this notice (37 CFR 1.181(n)). THIS TIME LIMIT MAY NOT BE EXTENDED PURSUANT TO 37 CFR 1.136. Failure to timely file a petition under 37 CFR 1.53(e) will result in the CPA request being retained in the file of the prior application but treated as never having been filed, in which case applicant may request a refund of the CPA filing fee (if submitted) less the \$130.00 handling fee (37 CFR 1.21(n)).

- ☐ 1. The prior application is not a complete (37 CFR 1.51(b)) application or the national stage of a PCT international application that is in compliance with 35 U.S.C. 371.
- ☐ 2. The request for a CPA was not filed before the payment of the issue fee on the prior application. The issue fee was paid on the prior application on \_\_\_\_\_.
- ☐ 3. The request for a CPA was not filed before the abandonment of, or termination of proceedings on, the prior application. The prior application was abandoned, or proceedings terminated on \_\_\_\_\_.
- ☐ 4. A petition for an extension of time under 37 CFR 1.136(a) accompanied by the appropriate fee (37 CFR 1.17(a)) are necessary to establish copendency between the prior application and this CPA request.

☒ 5. OTHER: *Prior Application was filed after 5/29/00, therefore future CPAs must be filed as RCE with a response and prior application was under final Rejection.*  
A copy of this notice **MUST** be returned with the reply.

Direct any questions about this Notice to:

C. Styles

Examining group 1624

(703) 30 8-4317

Form 1-2000 (Rev. 2/99)

PART 1 - ATTORNEY/APPLICANT COPY

8/11/01  
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